

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No. 09/376,880  
Attorney Docket No. A8135

**REMARKS**

**I. Introduction**

New claims 28-33 are added. Therefore, by this Amendment, claims 1-33 are pending in the Application. In the Office Action, claims 1-27 were examined. The Examiner rejected claims 1-6, 10-15, and 19-24 under 35 U.S.C. § 102(b) as allegedly being anticipated by Raman, U.S. Patent No. 6,134,598. Furthermore, the Examiner rejected claims 7-9, 16-18, and 25-27 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Raman in view of Guck, U.S. Patent No. 5,911,776. Applicants traverse the rejections of claims 1-27 for at least the following exemplary reasons.

**II. Rejections under 35 U.S.C. § 102**

Claims 1-6, 10-15, and 19-24 stand rejected as allegedly being anticipated by Raman.

**A. *Claims 1, 10, and 19***

Applicants traverse the rejection of independent claims 1, 10, and 19 because Raman fails to disclose each and every feature recited therein. For example and not by way of limitation, claims 1, 10, and 19 each recite "returning a locator to the client computer for locating the converted data". Conversely, Raman discloses that the actual converted data is transmitted over the network to the client system. *See, e.g.*, Fig. 1b, element 18; col. 3, lines 8-13 of Raman. Returning the actual converted data is not the same as "returning a locator to the client computer

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No. 09/376,880  
Attorney Docket No. A8135

for locating the converted data". Thus, Raman fails to disclose the recited feature of "returning a locator to the client computer for locating the converted data", as recited in claim 1, 10, and 19.

*B. Claims 2-6, 11-15, and 20-24*

Applicants traverse the rejections of claims 2-6, 11-15, and 20-24 at least by virtue of their dependency.

**III. Rejections under 35 U.S.C. § 103**

Claims 7-9, 16-18, and 25-27 stand rejected as allegedly being unpatentable over Raman in view of Guck.

*A. Claims 7-9, 16-18, and 25-27*

Applicants traverse the rejections of claims 7-9, 16-18, and 25-27 because the combination of Raman and Guck fails to teach or suggest all of the features recited therein. Claims 7-9, 16-18, and 25-27 respectively depend from claims 1, 10, and 19. As discussed above, Raman fails to disclose the feature of "returning a locator to the client computer for locating the converted data", as recited in claims 1, 10, and 19.

Furthermore, Guck fails to make up for this deficiency of Raman because Guck fails to disclose, teach, or suggest the feature of "returning a locator to the client computer for locating the converted data", as recited in claims 1, 10, and 19. To the contrary, Guck discloses that when a client requests data from a shadow file, the shadow file fetches the contents of its source file, calls on its converter to convert the contents of the source file into an output content, and returns

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No. 09/376,880  
Attorney Docket No. A8135

the transformed output content back to the requesting client. *See, e.g.*, col. 16, lines 45-60 of Guck. Returning the actual converted data is not the same as "returning a locator to the client computer for locating the converted data".

Thus, the combination of Raman and Guck fails to disclose, teach, or suggest all of the features recited in claims 1, 10, and 19 so as to establish a *prima facie* case of obviousness. Therefore, claims 7-9, 16-18, and 25-27 are patentable over the combination of Raman and Guck at least by virtue of their dependency.

#### **IV. Formal Matters**

##### *A. Priority*

The Examiner failed to acknowledge Applicants' claim for domestic priority under 35 U.S.C. § 119(e) from U.S. Provisional Application No. 60/107,395. Accordingly, Applicants respectfully request that the Examiner acknowledge Applicants' claim on or before the date of the next Action.

##### *B. Information Disclosure Statement*

The Examiner failed to provide a signed and initialed copy of the IDS filed on September 14, 1999, thereby indicating consideration of the reference cited therein. Accordingly, Applicants respectfully request that the Examiner provide such a copy on or before the date of the next Action.

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No. 09/376,880  
Attorney Docket No. A8135

*C. Drawings*

The Form PTO-948 indicates that the drawings filed on August 18, 1999 are objected to because of various informalities. However, Applicants believe that the formal drawings deposited on September 28, 1999 overcome these informalities. Accordingly, Applicants are resubmitting these formal drawings along with a copy of the original transmittal sheet and the OIPE-stamped receipt.

*D. Form PTO-892*

A review of the Form PTO-892 provided in the Office Action reveals errors on lines C, D, E, and G with respect to the listed classifications. Accordingly, Applicants respectfully request that the Examiner provide a corrected form 892 on or before the date of the next Action.

*E. Claims*

Applicants amend claims 18 and 27 to recite the feature of "retrieving the converted data from the server computer using the locator". These amendments provide an additional scope of coverage not provided by the other claims.

**V. New Claims 28-33**

Applicants add new claims 28-33. Claims 28-30 recite additional disclosed, yet previously unclaimed, features. For example, claims 28-30 provide for "deleting the stored converted data after a predetermined period of time". Claims 31-33 provide an additional scope of coverage not provided by the other claims. Thus, Applicants submit that new claims 28-33 are patentable at least by virtue of their dependency and the additional features recited therein.

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No. 09/376,880  
Attorney Docket No. A8135

**VI. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Billy Carter Raulerson  
Registration No. 52,156

SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, D.C. 20037-3213  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

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AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No. 09/376,880  
Attorney Docket No. A8135

**APPENDIX**

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

**The claims are amended as follows:**

18. (Amended) The apparatus of claim 17, wherein the client computer has a Web browser, and further comprising means for, under control of the Web browser, retrieving the converted data from the server computer using the ~~generated path name~~ locator.
27. (Amended) The article of manufacture of claim 26, wherein the client computer has a Web browser, and further comprising the step of, under control of the Web browser, retrieving the converted data from the server computer using the ~~generated path name~~ locator.

**Claims 28-33 are added as new claims.**